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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/693,433 | 10/24/2003 | Arthur H. Konwinski | SP-1309 | 2019 |
| 44388 | 7590 | 07/08/2005 | EXAMINER | |
| SOLAE, LLC P. O. BOX 88940 ST. LOUIS, MO 63188 | | | COE, SUSAN D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1655 | |
| DATE MAILED: 07/08/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/693,433

Applicant(s)

KONWINSKI ET AL.

Examiner

Susan D. Coe

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The amendment filed April 19, 2005, has been received and entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior Office action.
2. Claims 1-20 are pending.

Terminal Disclaimer

The terminal disclaimer filed on April 19, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Application No. 10/197,297 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

3. Claims 1, 3, 5-7, 10, and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5,505,946 for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the reference does not anticipate the claimed invention because the reference does not use an acetone precipitation step before the ultrafiltration step. However, as discussed in the previous Office action, Example 1 in the reference teaches using acetone to precipitate the Bowman-Birk Inhibitor (see column 12, lines 54-57). Ultrafiltration is performed after this step (see column 12, lines 64-65). Thus, the reference teaches an acetone precipitation followed by ultrafiltration.

Applicant also argues that the reference does not anticipate the present invention because reference includes an alcohol extraction step that is not included in the present invention.

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However, applicant's claims use the transitional phrase "comprising" that does not exclude additional steps in the method even if they are not specifically claimed (see MPEP section 2111.03). In addition, applicant argues that the reference is not using acid-extracted solubles. However, the reference uses acid to produce a soybean extract prior to the acetone precipitation (see column 12, lines 52-53). Thus, the reference is considered to be using acid extracted solubles from defatted soybean. Therefore, the reference is still considered to anticipate the stated claims because it teaches a method of making a Bowman-Birk inhibitor that comprises all of the steps claimed by applicant.

Claim Rejections - 35 USC § 103

4. Claims 1, 2, 4-13, and 16-20 rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,505,946 for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues against this rejection for the same reasons as in the traversal of the 102 rejection based on this reference. Therefore, the rejection is considered valid for the reasons stated above.

5. Claims 1-20 are provisionally rejected under 35 U.S.C. 103(a) as being obvious over US Pat. No. 6,887,498 (previously copending Application No. 10/197,297) in view of US Pat. No. 5,505,946 for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the references taken together do not render obvious the claimed invention due to the unexpected superior levels of chymotrypsin

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inhibition in the product produced according to the claims. However, this is not persuasive because both references teach purification of the soybean produces a better level of chymotrypsin inhibition. Thus, it is reasonable to expect that the two purification methods taken together would produce a product with greater levels of chymotrypsin inhibition in comparison with the prior art.

6. No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding can be directed to the receptionist whose telephone number is (571) 272-1600.

Susan D. Coe
7-6-05

Susan D. Coe
Primary Examiner
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